

NOTE This order is nonprecedential

**United States Court of Appeals
for the Federal Circuit**

FLFMC, LLC,
Plaintiff-Appellant,

v.

WHAM-O, INC.,
Defendant-Appellee

v.

UNITED STATES,
Intervenor

02-2011-1067-301102

2011-1067

Appeal from the United States District Court for the
Western District of Pennsylvania in case no. 01-CV-0435,
Judge Arthur J. Schwab

Decided October 19, 2011

Before LINN, DYK, and PROST, *Circuit Judges*
PER CURIAM

O R D E R

FLFMC, LLC (“FLFMC”) appealed from a decision of the United States District Court for the Western District of Pennsylvania dismissing its complaint, under 35 U S C § 292, for lack of Article III standing. Wham-O, Inc (“Wham-O”) asserted alternative grounds for affirmance, including challenges to the constitutionality of § 292(b) under the Take Care Clause of Article II § 3 and under the Appointments Clause of Article II § 2. This court heard oral argument on July 7, 2011.

On September 16, 2011, the President signed into law the Leahy-Smith America Invents Act, H R 1249, 112th Cong (1st Sess 2011), amending 35 U S C § 292 to eliminate the *qui tam* provision on which this action was predicated. This act included the following text regarding the effective date of this provision: “The amendments made by this subsection shall apply to all cases, without exception, that are pending on, or commenced on or after, the date of the enactment of this Act.” Leahy-Smith America Invents Act, Pub L No 112-29 § 16(b)(4), 125 Stat 284, 329 (2011) (“the Act”). Accordingly, on September 16, 2011, the court ordered the parties to advise the court of the effect of this legislation on the status of the case.

On September 30, 2011, FLFMC, Wham-O, Inc, and the United States filed a joint-response to the court’s order. In this response, the parties agreed that the Act rendered this appeal and the standing determination of the district court moot. Accordingly, they requested the court to vacate the district court’s decision dismissing the case for lack of standing and to dismiss this appeal.

In light of the amendments to 35 U S C § 292 and the parties’ agreement on the effect of the Act under the facts and circumstances of this case, this appeal is dismissed as

moot¹. Because the circumstance that rendered this case moot was the amendment of § 292(b) by Congress, over which the parties had no control, it is appropriate not only to dismiss the appeal but to vacate the district court's determination as well. 28 U.S.C. § 2106, *see Alvarez v. Smith*, 130 S.Ct. 576, 581 (2009) ("Applying this statute, we normally do vacate the lower court judgment in a moot case because doing so 'clears the path for future relitigation of the issues between the parties,' preserving 'the rights of all parties,' while prejudicing none 'by a decision which was only preliminary.'") (citing *United States v. Munsingwear, Inc.*, 340 U.S. 36, 40 (1950))), *Tafas v. Kappos*, 586 F.3d 1369, 1371 (Fed. Cir. 2009) ("Vacatur is appropriate if the mootness arises from external causes over which the parties have no control") (citing *U.S. Bancorp Mortg. Co. v. Bonner Mall P'ship*, 513 U.S. 18, 25 (1994)))

Accordingly,

IT IS ORDERED THAT

- (1) The district court's decision dismissing the case for lack of standing is vacated as moot
- (2) The case is remanded with instructions to dismiss
- (3) This appeal is dismissed
- (4) Each party shall bear its own costs

¹ The parties do not challenge, and this court does not address, the constitutionality of the retroactive application of the amendments to § 292

FLFMC v WHAM-O

FOR THE COURT,

October 19, 2011

/s/JanHobaly

Date

Jan Horbaly
Clerk

cc David G Oberdick, Esq
Andrew J Dhuey, Esq
Douglas N Letter, Esq

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 19 2011

JAN HORBALY
CLERK